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10/715,962	11/18/2003	Rainer Birkenbach	SCHWP0184USA	5397
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EXAMINER				
KASZTEJNA, MATTHEW JOHN				
ART UNIT		PAPER NUMBER		
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/715,962

Applicant(s)

BIRKENBACH ET AL.

Examiner

MATTHEW J. KASZTEJNA

Art Unit

3739

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 July 2008.
2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 2,3,6,9,10,20,22 and 24-28 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 2,3,6,9,10,20,22 and 24-28 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☒ The drawing(s) filed on 29 April 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____

DETAILED ACTION

Notice of Amendment

In response to the amendment filed on July 22, 2008, amended claims 2-3, 6, 9, 20, 22, 24 and 26; canceled claim 1 and new claim 27-28 are acknowledged. The current rejections of the claims are *withdrawn*. The following new grounds of rejection are set forth:

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 20 and 28 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Claim 20 recites "wherein the central control unit is configured to receive output signals and relay received input signals *without conversion* of the received input signals to command protocols of the least two medically applicable apparatuses". However, contradicting this limitation, applicant states that "one or more processors 21 can be provided in the central control unit 2, to *convert* the control signals coming from the screen 4 into formats corresponding to the respective control apparatus 3a-3d, which can be forwarded to the corresponding control apparatus 3a-3d via the lines 5a-5d (see paragraph 0034 of applicant's

specification). Thus, it is unclear how it is claimed that the control unit relays input signals to the medical apparatuses *without* conversation of these signals, when the specification clearly states that at least one processor receives inputted control signals, *converts* the control signals into formats corresponding to the respective at least two control apparatuses, and transfers the *converted* control signals to the at least two control apparatuses to control the at least two medically applicable instruments.

Claim 27 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Claim 27 recites "wherein the central control unit is configured to receive input signals from the at least one input device and forward the received input signals to the at least two control apparatuses *without* controlling the medically applicable apparatuses." It is unclear how the system would work if the central control unit does not ultimately control the medical apparatus. As disclosed by the applicant, the central control system receives inputted control signals, which are then transferred to the at least two control apparatuses to control the at least two medically applicable instruments (see paragraph 0034 of applicant's specification). Thus, the central control system does in fact passively control the medical instruments. If the central control system fails to transfer the inputted signal to the control apparatuses, then the medical instruments will never receive any inputted signals and thus can not be controlled via the inputted signals from the input device. If no inputted signals are received to control the medical instruments

then the main objective of the system appears to be defeated. It is unclear what is meant by the terminology "without controlling the medically applicable apparatuses".

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 2-3, 6, 9-10, 20, 22 and 24-28 are rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent No. 5,788,688 to Bauer et al.

In regards to claims 20, Bauer et al. disclose a system comprising: a central control unit 66 configured to couple to input and output connections of at least two medically applicable instruments 54, 64, 74, 60 via at least two control apparatuses 49, 44, 46, 48, 50 having different manufacturer-specific command protocols and associated command protocol software (see Col. 3, Lines 1-20); and a common output display device 70 coupled to the central control unit via a bus, wherein the bus provides electrical separation between the common output display device and the central control unit (see Fig. 3); at least one input device 70 coupled to the central control unit and configured to receive operator input (see Fig. 4); wherein the central control unit is configured to receive output signals from the at least two control apparatuses and adapt the received output signals for display on the common output display device, and the

central control unit is configured to receive input signals from the at least one input device and relay the received input signals to the at least two control apparatuses (see Fig. 2 Col. 7, Lines 5-35); and wherein the central control unit is configured to receive output signals and relay received input signals without conversion of the received input signals to command protocols of the least two medically applicable apparatuses (see Fig. 1).

In regards to claim 22, Bauer et al. disclose a system, wherein the common output display device 70 is a single input and output display device comprised of a single touch screen display (see Figs. 2-3 and CO. 9, Lines 1-52).

In regards to claim 24, Bauer et al. disclose a system, a system including at least two medically applicable apparatuses 54, 64, 74, 60, the medically applicable apparatuses each being coupled to a different control apparatus 44, 46, 48, 50 (see Fig. 2), the control apparatuses having different manufacturer-specific input and output specifications, a central interface unit 66 coupled to input and output connections of said at least two control apparatuses (see Fig. 1 and Col 3, Lines 1-20), wherein the central interface unit includes at least one processor 78 that is configured to convert different manufacturer-specific display information and/or image formats from the control apparatuses into a predetermined, defined image format for display on a common output display device 68 (see Col. 7, Lines 50-67), wherein the central interface unit is configured to provide selective display of output data from the medically applicable apparatuses alone or in combination on the common output display device (see Col. 8, Lines 1-15).

In regards to claim 25, Bauer et al. disclose a system, wherein the central interface unit provides for selective display of data from different medically applicable apparatuses alone or in combination on the single output display device (see Fig. 2 and Col. 3, Lines 20-37 and Col. 4, Lines 28-33).

In regards to claims 27-28, Bauer et al. disclose a system comprising a central control unit 66 configured to couple to input and output connections of at least two medically applicable instruments 54, 64, 74, 60 via at least two control apparatuses having 44, 46, 48, 50 different manufacturer-specific command protocols and associated command protocol software (see Fig. 1 and Col 3, Lines 1-20); a common output display device 68 coupled to the central control unit via a bus, wherein the bus provides electrical separation between the common output display device and the central control unit; and at least one input device 70 coupled to the central control unit and configured to receive operator input; wherein the central control unit is configured to receive input signals from the at least one input device and forward the received input signals to the at least two control apparatuses without controlling the medically applicable apparatuses (see Fig. 2 and Col. 3, Lines 20-37 and Col. 4, Lines 28-33).

In regards to claim 26, Bauer et al. disclose a system, wherein the input device 70, the common output device 54, and the at least two medically applicable instruments are positioned in an operating theater 32, and the central control unit 66 and the at least two control apparatuses are positioned outside the operating theater (see Fig. 1 and Col. 6, Lines 30-35).

In regards to claim 2, Bauer et al. disclose a system, wherein the central control unit includes at least one processor 78, which converts different display information and/or image formats into a predetermined, defined image format (see Figs. 3 and Col. 7, line 50 – Col. 8, Line 15).

In regards to claim 3, Bauer et al. disclose a system, wherein the at least two control apparatuses coupled to the at least two medical apparatus are provided in a rack 42 (see Fig. 1 and Col. 6, Lines 50-53).

In regards to claim 6, Bauer et al. disclose a system, wherein the input device 70 comprises a touch pad (see Fig. 4).

In regards to claim 9, Bauer et al. disclose a system, further comprising a storage device 80, 82 (see Fig. 3). The word “for” in the claim may be properly interpreted as “capable of,” and “capable of” does not require that reference actually teach the intended use of the element, but merely that the reference does not make it so it is incapable of performing the intended use.

In regards to claim 10, Bauer et al. disclose a system, wherein at least one device 68 forming the system being mounted to a ceiling of an associated operating room (see Fig. 1 and Col. 4, Lines 28-33).

Response to Arguments

Applicant's arguments with respect to claims 2-3, 6, 9-10, 20, 22 and 24-28 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to **MATTHEW J. KASZTEJNA** whose telephone number is (571)272-6086. The examiner can normally be reached on **Mon-Fri, 8:30-6:00**.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Linda C.M. Dvorak can be reached on (571) 272-4764. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/M. J. K./
Examiner, Art Unit 3739

/Linda C Dvorak/
Supervisory Patent Examiner, Art
Unit 3739

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